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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/624,285	07/24/2000	Michael Maguire	555255012115	6347

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EXAMINER
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STORK, KYLE R

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 12/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/624,285	<b>Applicant(s)</b> MAGUIRE, MICHAEL	
	<b>Examiner</b> Kyle R. Stork	<b>Art Unit</b> 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2005.
- 2a) ☒ This action is **FINAL**.      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 22-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This final office action is in response the amendment filed 14 October 2005.
2. Claims 22-50 are pending. Claims 22, 34, and 45 are independent claims. Claims 34-50 are newly added by the amendment.

### *Oath/Declaration*

3. The declaration filed on 8 August 2005 under 37 CFR 1.131 has been considered, but is ineffective to overcome the Nicolas reference.

Applicant attempts to establish a prior invention by showing a conception prior to June 29, 2001, the effective date of the Nicolas reference, coupled with diligence from just prior to that date until the filing of this application on October 24, 2002..

The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show.

A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131. (MPEP 715.07)

The affidavit or declaration and exhibits ***must clearly explain*** which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. ***Vague and general statements*** in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice ***"amounts essentially to mere pleading***, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred."). (MPEP 715.07) [Emphasis added]

#### ***a. Conception***

4. Applicant relies upon the invention disclosure document of 21 May 2001 to establish conception. The statement in the affidavit to support conception is " Prior to May 18, 2000, I conceived of the subject matter described and claimed in the above-

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titled patent application. Evidence of this conception is set forth at Tab A hereto. The document at Tab A is an invention disclosure form that I completed well before May 18, 2000. The invention disclosure form is titled "Graphical Abbreviation of Structured Information for Small Browsers." This document was provided to the assignee's outside patent counsel prior to May 18, 2000 in order to provide the above titled patent application."

5. This is a general assertion of conception and therefore, "amounts essentially to mere pleading, unsupported by proof or a showing of facts' and, thus, does not satisfy the requirements of 37 CFR 1.131(b)" (MPEP 715.07). Proof of conception requires specifically explaining what the exhibit is relied upon to show. That is, there is no "clear explanation" (within the affidavit) of how the exhibit supports conception of the claimed invention.

6. Therefore, Applicant has not met her burden of showing prior conception of the claimed invention.

### ***b. Diligence***

Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather applicant must show evidence or facts establishing diligence (MPEP 715.07(a)).

What is meant by diligence is brought out in *Christie v. Seybold*, 1893 C.D. 515, 64 O.G. 1650 (6<sup>th</sup> Cir. 1893). In patent law, an inventor is either diligent at a given time or he is not diligent; there are no degrees of diligence. An applicant may be diligent within the meaning of the patent law when he or she is doing nothing, if his or her lack of activity is excused. Note, however, that the record must set forth an explanation or excuse for the inactivity; the USPTO or courts will not speculate on possible explanations for delay or inactivity. See *In re Nelson*, 420 F.2d 1079, 164 USPQ 458 (CCPA 1970). Diligence must be judged on the basis of the particular facts in each case. See MPEP 2138.06 for a detailed discussion of the diligence requirement for proving prior invention.

Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). Note, therefore, that only diligence before reduction to practice is a material consideration. The 'lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon' is not relevant to an affidavit or declaration under 37 CFR 1.131. See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947). (MPEP 715.07(a)).

7. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Nicolas reference to either a constructive reduction to practice or an actual reduction to practice. The applicant has merely relied upon the assertion that on "information and belief, both the inside patent counsel and the outside patent counsel were diligently working on this patent application from prior to May 18, 2000, up until the application was subsequently filed on July 24, 2000." This assertion fails to demonstrate "evidence or facts establishing diligence" for the "lapse of time between the completion or reduction of practice of an invention and the filing of an application thereon (MPEP 715.07(a))." Applicant has failed to demonstrate evidence or facts to show diligence from the date of the reference or activity through the date of a reduction to practice as required by the MPEP 715.07(a). Diligence requires that applicants be specific as to dates and facts.

8. For at least the reasons cited above the affidavit is ineffective to establish conception prior to May 18, 2000. Therefore the Nicolas rejection is maintained.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 22-30 and 32-33 remain rejected and claims 34-41 and 43-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bickmore, et al. (herein

after Bickmore) European Patent No. EP0949571 in view of Nicolas et al. (herein after Nicolas) U.S. Patent No. 6,593,944 B1 filed 5/18/2000

In regard to independent claim 22, Bickmore discloses A method of providing an information page to a handheld viewing device, comprising the steps of: requesting an information page at the handheld viewing device (Bickmore Paragraph 22 Line 3); retrieving the information page from a remote system (Bickmore Paragraph 29 Line 13).

Bickmore does not specifically mention if the information page includes a plurality of frames, then generating an abbreviated version of the information page, and an image map; and transmitting the abbreviated version of the information page to the handheld viewing device. However, Nicolas mentions determining a frame layout associated with said multi-frame Web Page; generating a frame representation for indicating said frame layout, wherein said frame representation includes a plurality of geometric frame identifiers each corresponding to a corresponding frame of said plurality of frames, each geometric frame identifier being configured for individual selection by a user; displaying said frame representation on said electronic display device such that said user can select anyone of said plurality of geometric frame identifiers to view corresponding one of said plurality of frames; and displaying on said electronic display device a selected frame corresponding to a selected geometric frame identifier in response to said user selecting said selected geometric frame identifier (Nicolas Col 3 Lines 28-45 and Col 12 Lines 32-60). It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply Nicolas to Bickmore, providing Bickmore the benefit of making an abbreviated frame

representation of the original web site and allowing the user to select frame identifiers for each frame so the user can easier view sections of the web site on a smaller display.

In regard to dependent claim 23, Bickmore discloses providing a gateway device for receiving the request from the handheld viewing device (Bickmore Paragraph 77 Line 34) and for retrieving the information page from the remote system. (Bickmore Paragraph 29 Line 13)

In regard to dependent claim 24, Bickmore discloses coupling the gateway device to the handheld viewing device via a wireless network. (Bickmore Paragraph 73 Lines 1-3)

In regard to dependent claim 25, Bickmore discloses coupling the gateway device to the remote system via a wired network. (Bickmore Paragraph 100 Line 26)

In regard to dependent claim 26, Bickmore discloses wherein the wired network is the Internet, and the remote system is a world-wide-web server. (Bickmore Paragraph 24 Line 53-56)

In regard to dependent claim 27, Bickmore discloses wherein the information page is a web page. (Bickmore Paragraph 118 Line 24 i.e. Web document)

In regard to dependent claim 28, Bickmore discloses wherein the gateway device stores the information page in a cache (Bickmore Paragraph 116 Line 9)

Bickmore does not specifically mention generating the abbreviated version thereof, including the image map. However, Nicolas mentions determining a frame layout associated with said multi-frame We Page; generating a frame representation for indicating said frame layout, wherein said frame representation includes a plurality of

geometric frame identifiers each corresponding to a corresponding frame of said plurality of frames, each geometric frame identifier being configured for individual selection by a user; displaying said frame representation on said electronic display device such that said user can select anyone of said plurality of geometric frame identifiers to view corresponding one of said plurality of frames; and displaying on said electronic display device a selected frame corresponding to a selected geometric frame identifier in response to said user selecting said selected geometric frame identifier (Nicolas Col 3 Lines 28-45 and Col 12 Lines 32-60). It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply Nicolas to Bickmore, providing Bickmore the benefit of making an abbreviated frame representation of the original web site and allowing the user to select frame identifiers for each frame so the user can easier view sections of the web site on a smaller display.

In regard to dependent claim 29, Bickmore does not specifically mention displaying the graphical representation of the information page at the handheld viewing device; selecting a portion of the graphical representation; accessing the image map to determine a frame that corresponds to the portion of the graphical representation selected; and retrieving a graphical representation of the selected frame and displaying it on the handheld viewing device. However, Nicolas mentions determining a frame layout associated with said multi-frame We Page; generating a frame representation for indicating said frame layout, wherein said frame representation includes a plurality of geometric frame identifiers each corresponding to a corresponding frame of said plurality of frames, each geometric frame identifier being configured for individual



selection by a user; displaying said frame representation on said electronic display device such that said user can select anyone of said plurality of geometric frame identifiers to view corresponding one of said plurality of frames; and displaying on said electronic display device a selected frame corresponding to a selected geometric frame identifier in response to said user selecting said selected geometric frame identifier (Nicolas Col 3 Lines 28-45 and Col 12 Lines 32-60). It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply Nicolas to Bickmore, providing Bickmore the benefit of making an abbreviated frame representation of the original web site and allowing the user to select frame identifiers for each frame so the user can easier view sections of the web site on a smaller display.

In regard to dependent claim 30, Bickmore discloses providing a uniform resource locator (URL) (Bickmore Paragraph 143 Line 36) and transmitting one of the uniform resource locators to the remote system (Bickmore Paragraph 143 Line 36 and Paragraph 29 Line 13).

Bickmore does not specifically mention associated with each of the plurality of frames identified by the image map. However, Nicolas mentions determining a frame layout associated with said multi-frame We Page; generating a frame representation for indicating said frame layout, wherein said frame representation includes a plurality of geometric frame identifiers each corresponding to a corresponding frame of said plurality of frames, each geometric frame identifier being configured for individual selection by a user; displaying said frame representation on said electronic display device such that said user can select anyone of said plurality of geometric frame

identifiers to view corresponding one of said plurality of frames; and displaying on said electronic display device a selected frame corresponding to a selected geometric frame identifier in response to said user selecting said selected geometric frame identifier (Nicolas Col 3 Lines 28-45 and Col 12 Lines 32-60). It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply Nicolas to Bickmore, providing Bickmore the benefit of making an abbreviated frame representation of the original web site and allowing the user to select frame identifiers for each frame so the user can easier view sections of the web site on a smaller display.

In regard to dependent claim 32, Bickmore discloses if the information page does not include a plurality of frames (Bickmore Figure 5), then transmitting the information page to the handheld viewing device without abbreviating it into the graphical representation and the image map. (Bickmore Paragraph 94 Lines 49)

In regard to dependent claim 33, Bickmore does not specifically mention prior to the transmitting step, reducing the size of the graphical representation of the information page to match the display characteristics of the handheld viewing device. However, Nicolas mentions determining a frame layout associated with said multi-frame Web Page; generating a frame representation for indicating said frame layout, wherein said frame representation includes a plurality of geometric frame identifiers each corresponding to a corresponding frame of said plurality of frames, each geometric frame identifier being configured for individual selection by a user; displaying said frame representation on said electronic display device such that said user can select anyone of said plurality of geometric frame identifiers to view corresponding one

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of said plurality of frames; and displaying on said electronic display device a selected frame corresponding to a selected geometric frame identifier in response to said user selecting said selected geometric frame identifier (Nicolas Col 3 Lines 28-45 and Col 12 Lines 32-60 and Col 2 Lines 20-25 i.e. reducing prior to displaying). It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply Nicolas to Bickmore, providing Bickmore the benefit of making an abbreviated frame representation of the original web site and allowing the user to select frame identifiers for each frame so the user can easier view sections of the web site on a smaller display.

As per independent claim 34, the applicant discloses the limitations similar to those in claims 22-24. Claim 34 is similarly rejected.

As per dependent claim 35, the applicant discloses the limitations similar to those in claim 23. Claim 23 is similarly rejected.

As per dependent claim 36, the applicant discloses the limitations similar to those in claim 25. Claim 36 is similarly rejected.

As per dependent claim 37, the applicant discloses the limitations similar to those in claim 26. Claim 37 is similarly rejected.

As per dependent claim 38, the applicant discloses the limitations similar to those in claim 27. Claim 38 is similarly rejected.

As per dependent claim 39, the applicant discloses the limitations similar to those in claim 28. Claim 39 is similarly rejected.

As per dependent claim 40, the applicant discloses the limitations similar to those in claim 29. Claim 40 is similarly rejected.

As per dependent claim 41, the applicant discloses the limitations similar to those in claim 30. Claim 41 is similarly rejected.

As per dependent claim 43, the applicant discloses the limitations similar to those in claim 32. Claim 43 is similarly rejected.

As per dependent claim 44, the applicant discloses the limitations similar to those in claim 33. Claim 44 is similarly rejected.

As per independent claim 45, the applicant discloses the limitations similar to those in claim 22. Claim 45 is similarly rejected.

As per dependent claim 46, the applicant discloses the limitations similar to those in claim 22. Claim 46 is similarly rejected.

As per dependent claim 47, the applicant discloses the limitations similar to those in claim 23. Claim 47 is similarly rejected.

As per dependent claim 48, the applicant discloses the limitations similar to those in claim 24. Claim 48 is similarly rejected.

As per dependent claim 49, the applicant discloses the limitations similar to those in claim 29. Claim 49 is similarly rejected.

11. Claim 31 remains rejected and claims 42 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bickmore, et al. (herein after Bickmore) European

Patent No. EP0949571, in view of Baecker et al. (herein after Baecker) U.S. Patent 5,479,602 (Provided to the applicant in the previous office action).

In regard to dependent claim 31, Bickmore does not specifically mention a bitmap. However, Baecker mentions a bitmap (Baecker Col 4 Line 3-4) It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply Baecker to Bickmore, providing Bickmore the benefit of using the icon bitmap as a small portion of random access memory, or a portion of the data storage device that is used to store a computer compatible representation of the icon as taught by Baecker Col 5 Lines 13-29.

As per dependent claim 42, the applicant discloses the limitations similar to those in claim 31. Claim 42 is similarly rejected.

As per dependent claim 50, the applicant discloses the limitations similar to those in claim 31. Claim 50 is similarly rejected.

### ***Response to Arguments***

12. Applicant's arguments filed 14 October 2005 have been fully considered but they are not persuasive.

The applicant's claims focus upon their belief that the affidavit filed 8 August 2005 overcome the Nicolas reference. However, as disclosed above, the affidavit fails to overcome the reference. This argument is therefore not persuasive.

### ***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

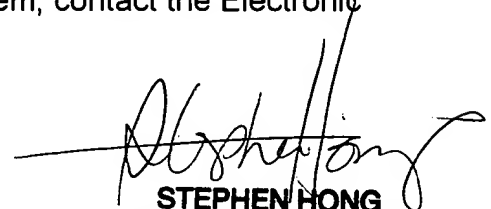
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle R. Stork whose telephone number is (571) 272-4130. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kyle Stork  
Patent Examiner  
Art Unit 2178



**STEPHEN HONG**  
SUPERVISORY PATENT EXAMINER

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